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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,144	09/20/2000	Vaijayanti A. Kumar	273944	5793

26694 7590 10/24/2005

VENABLE LLP  
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EXAMINER

ANGELL, JON E

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/666,144

Applicant(s)

KUMAR ET AL.

Examiner

Jon Eric Angell

Art Unit

1635

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 14-16, 19, 20, 24 and 25.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 17, 18 and 21-23.  
Claim(s) withdrawn from consideration: 10-12.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Anne-Marie Falk*

ANNE-MARIE FALK, PH.D  
PRIMARY EXAMINER

Jon Eric Angell

Continuation of 3. NOTE: The proposed amendment filed 9/29/05 would raise new issues that require further consideration and further search. Specifically, the proposed amendment to claims 22 and 23 would change the claims from a process for sequence specific recognition of a single or double stranded DNA or RNA by oligomers as in claims 14/15 using compounds of formulae 4a and 6a according to claim 7, to a process for sequence specific recognition of a single or double stranded DNA or RNA compound according to claims 14/15 using compounds of formulae 4a and 6a. As such, the amendment would change the method from a method for sequence specific recognition of DNA or RNA molecule using the oligomers of claims 14/15 to a method sequence specific recognition of the oligomers of claims 14/15. This change would change the nature of the claim such that new considerations and searching would be required for the new embodiments of claims 22 and 23. Furthermore, it is respectively pointed out that the new limitations would necessitate consideration of new rejections under 35 USC 112, 2nd paragraph, as there does not appear to be proper antecedent basis for "single and double stranded DNA or RNA compounds according to claims 14 and 15" as claims 14 and 15 do not encompass single or double stranded DNA/RNA. Additionally, the proposed amended claims 22 and 23 appear to be missing essential method steps. Specifically, claims 14 and 15 do not appear to set forth the steps indicating how the compounds of formulae 4a and 6a are used in the method. Since the proposed amendment would require further search and considerations, the amendment has not been entered, and the claims remain rejected for the reasons indicated in the Office Action mailed 6/29/2005 .

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments are in view the proposed amendment to the claims, which has not been entered for the reasons indicated herein. Since the amendment as not been entered, Applicants arguments are not persuasive.